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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

OPTIMIZE TECHNOLOGIES, INC.,

Opposer,

v.

WICOM GMBH,

Applicant.

Opposition No. 91158331

MOTION TO CONSOLIDATE
OPPOSITION PROCEEDINGS

03-19-2004

U.S. Patent & TMO/TM Mail Rcpt Dt #22

Pursuant to Federal Rule of Civil Procedure 42(a), as made applicable by Trademark Rule 2.116(a), Opposer hereby moves that Opposition Proceeding Numbers 91158331 and 91156666 be consolidated.

On March 15, 2004, Opposer, by telephone conference with Stanley C. Macel, III, Applicant's attorney, requested consent to consolidate these matters and to designate Opposition No. 91158331 as the parent matter. Mr. Macel declined to grant consent.

Opposer has filed Notices of Opposition against U.S. Trademark Application Numbers 78/176,019 (OPTI-LIGHT) and 78/095,516 (OPTIFLOW). These Notices of Opposition are now Opposition Proceeding Numbers 91158331 and 91156666. As set forth in the accompanying Memorandum in Support of the Motion to Consolidate Opposition Proceedings, the two Opposition Proceedings involve identical parties and common questions of law and fact and consolidation would therefore be appropriate to avoid duplication of effort concerning the factual issues in common, thereby avoiding unnecessary costs and delays.

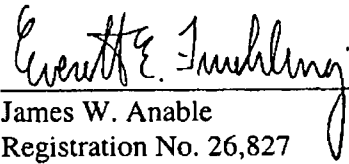
Opposer requests that the present Opposition Proceeding, Number 91158331 be designated as the "parent" case in which all papers shall be filed, adopting the trial and

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1 deadline schedule of Opposition Proceeding Number 91158331, notwithstanding every paper
2 henceforth referencing both proceeding numbers.

3 Dated this 16th day of March 2004.

4
5 CHRISTENSEN O'CONNOR
6 JOHNSON KINDNESS^{PLLC}

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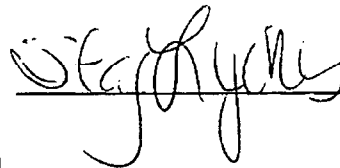
10 James W. Anable
11 Registration No. 26,827
12 Everett E. Fruehling
13 Attorneys for Opposer Optimize
14 Technologies, Inc.

15 CERTIFICATE OF SERVICE

16 I hereby certify that on the 16th day of March 2004, a true copy of the foregoing Motion to Consolidate
17 Opposition Proceedings, in Opposition No. 91158331, was served on attorneys for Applicant by depositing a
18 true and correct copy thereof in the United States mail in a sealed envelope with postage thereon fully prepaid,
19 addressed as follows:

20 Stanley C. Macel, III, Esq.
21 Connolly Bove Lodge & Hutz LLP
22 1007 North Orange Street
23 Wilmington, DE 19899

24 Executed on March 16, 2004

25 
26

27 EEF:skk

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

OPTIMIZE TECHNOLOGIES, INC.,

Opposer,

v.

WICOM GMBH,

Applicant.

Opposition No. 91158331

MEMORANDUM IN SUPPORT
OF MOTION TO CONSOLIDATE
OPPOSITION PROCEEDINGS



03-19-2004

U.S. Patent & TMO/TM Mail Rpt Dt. #1

I. INTRODUCTION

Pursuant to Federal Rule of Civil Procedure 42(a), as made applicable by Trademark Rule 2.116(a), this Memorandum and the accompanying Motion and Order request that Opposition Proceeding Numbers 91158331 and 91156666 be consolidated.

The two Opposition Proceedings at issue address Opposer Optimize Technologies, Inc.'s objection to the registration of Applicant Wicom GmbH's U.S. Trademark Application Numbers 78/176,019 and 78/095,516 for the marks OPTI-LIGHT and OPTIFLOW, respectively. As shown below, the two Opposition Proceedings involve identical parties and common questions of fact and law. Consolidation would therefore be appropriate to avoid duplication of effort concerning the factual and legal issues in common, and would avoid unnecessary costs and delays.

Opposer requests that the present Opposition Proceeding, Number 91158331, be designated as the "parent" case in which all papers shall be filed, adopting the trial and deadline schedule of Opposition Proceeding Number 91158331, notwithstanding every paper henceforth referencing both proceeding numbers.

II. ARGUMENT AND CITATION TO AUTHORITY

Where more than one opposition or cancellation is pending between the same two parties involving the identical trademark or trademarks with common elements, the Trademark Trial and Appeal Board will frequently grant a motion to consolidate the proceedings into one. TBMP § 511; *G-Mar Development Corp. v. Tully's Coffee Corp.*, 46

MEMORANDUM IN SUPPORT OF OPPOSITION
MOTION TO CONSOLIDATE OPPOSITION
PROCEEDINGS - 1
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1 USPQ2d 1797 (TTAB 1998); *S. Industries, Inc. v. Lamb-Weston, Inc.*, 45 USPQ2d 1293
2 (TTAB 1997). Assuming there are common questions of fact or law, this procedure can
3 establish significant economies by providing for the same testimony periods and a single
4 brief, hearing, and decision. FRCP 42(a); TBMP § 511; *Regatta Sport Ltd. v. Telux-Pioneer*
5 *Inc.*, 20 USPQ2d 1154 (TTAB 1991).

6 The parties in Opposition Proceeding Numbers 91158331 and 91156666 are the same
7 and the two Proceedings involve substantially identical questions of fact and law. The marks
8 sought to be registered by Applicant are highly similar, and Opposer has challenged
9 Applicant's right to register the OPTIFLOW and OPTI-LIGHT marks on the same basis,
10 namely, Opposer's prior use and registration of substantially similar marks.

11 **A. Opposition Numbers 91158331 and 91156666 Involve Identical Parties, Similar**
12 **Marks, and Common Facts**

13 **1. The Parties, and Their Counsel, Are Identical in Each Opposition.**

14 On May 1, 2003, Optimize Technologies, Inc., through undersigned counsel, filed a
15 Notice of Opposition with the Trademark Trial and Appeal Board against Applicant Wicom
16 GmbH for its Trademark App. No. 78/095,516 for the mark **OPTIFLOW**. Then, on October
17 20, 2003, Opposer filed a Notice of Opposition with the Trademark Trial and Appeal Board
18 against Applicant for its U.S. Trademark App. No. 78/176,019 for the mark **OPTI-LIGHT**.
19 As stated in both Notices of Opposition, Opposer believes it will be damaged by registration
20 of the marks OPTI-LIGHT or OPTIFLOW on account of Opposer's previous applications and
21 registrations for the following marks: OPTI, OPTI-GUARD, OPTI-MAX, OPTI-SEAL,
22 OPTIMIZE TECHNOLOGIES, OPTI-PAK, and OPTI-SOLV (the "OPTI marks").

23 Applicant retained the same counsel, Stanley C. Macel, III, to represent it in both
24 Opposition Proceedings, who answered the respective Notices on September 17, 2003 (as
25 amended on March 2, 2004) and December 12, 2003. Thus the parties, and their counsel, in
26 both Opposition Proceedings, are identical.

2. The Marks at Issue in Each Opposition, and the Goods Associated with Them, Are Very Similar

Opposer's OPTI marks and Applicant's applied-for marks all involve the initial term OPTI, making them all closely similar in sight, sound, and meaning. Opposer's family of OPTI marks all relate to goods associated with chemical analysis and laboratory testing equipment, and in particular, filters, columns, valves, seals, and other similar components for use with high pressure liquid chromatography ("HPLC") equipment in International Class 9. On their face, these goods could be considered very similar or identical to the goods claimed in the applications subject to this Motion to Consolidate.

In its Answer of December 12, 2003, Applicant admitted that its broad category of goods in International Class 9 associated with the mark OPTI-LIGHT, namely, "analytical devices and systems for use in chemical analysis and replacement parts therefor," includes Opposer's HPLC filters, in-line filters, precolumn filters, piston and plunger seals, tubing, check valves, and other similar goods that are also used in a laboratory for the chemical analysis of laboratory samples. Applicant further admitted in its Answer that its chromatography chemicals and analytical devices and systems are virtually identical in their application as Opposer's HPLC product line. Applicant went on to admit Opposer's other HPLC components are also very similar to Applicant's chromatography chemicals because Applicant's chemicals are used with the same HPLC equipment as Opposer's other HPLC components, sample processor components, and HPLC maintenance kits.

Likewise, in its OPTIFLOW application, Applicant described its goods in International Class 9 as "laboratory filters for purification and cleaning of fluid laboratory samples, sold separately." Applicant initially admitted that these goods are "virtually identical" to Opposer's goods, but on March 2, 2004, amended its September 17 Answer to instead deny any similarity. Nonetheless, the description of goods has not changed, and, on its face, is similar or identical to Opposer's goods. Opposer argues that the goods represented

1 by both of Applicant's marks are sufficiently related to Opposer's goods as to cause a
2 likelihood of confusion.

3 Significantly, in Applicant's Answers of both September 17 and December 12, 2003,
4 Applicant further admitted that its goods and Opposer's goods are sold in the same channels
5 of trade to the same consumers or class of consumers, namely, university research
6 laboratories, biotech research laboratories, pharmaceutical manufacturers, crime investigation
7 laboratories, hospitals, and other institutions performing liquid study and analysis.

8 Based on the Notices of Opposition and Applicant's Answers, these two Oppositions
9 involve identical parties, identical counsel, similar marks covering similar goods, similar
10 channels of trade, and common facts. In light of these similarities, Opposer respectfully
11 suggests that it would be most efficient for the Oppositions to be consolidated. Furthermore,
12 in both Oppositions Opposer has raised virtually identical defenses.

13 **B. Opposition Numbers 91158331 and 91156666 Each Involve Common Questions**
14 **of Law Regarding Likelihood of Confusion, False Association and Damage to**
15 **Opposer**

16 **1. The Applications for the Marks OPTIFLOW and OPTI-LIGHT Raise**
17 **Virtually Identical Issues and Arguments Regarding Likelihood of**
18 **Confusion with Opposer's Marks OPTI, OPTI-GUARD, OPTI-MAX,**
19 **OPTI-SEAL, and OPTIMIZE TECHNOLOGIES.**

20 Opposer argues in both proceedings that Opposer's OPTI, OPTI-GUARD, OPTI-
21 MAX, OPTI-SEAL, and OPTIMIZE TECHNOLOGIES marks are confusingly similar to
22 Applicant's OPTIFLOW and OPTI-LIGHT marks, and that the parties' respective goods are
23 very similar and closely related. Opposer believes that these similarities are likely to cause
24 consumer confusion, mistake, or deception that Applicant's goods are associated with or
25 otherwise endorsed, sponsored, or approved by Opposer and that this will cause damage to
26 Opposer.

27 Clearly the issues regarding similarities of the marks, the goods, the channels of trade,
and the relevant customers are practically identical in the two Opposition Proceedings at
issue. This sets forth a legal issue in common to both Opposition Proceedings: that

1 Applicant's marks are likely to cause confusion and damage to the Opposer under the
2 provisions of Section 2(d) of the U.S. Trademark Act, 15 U.S.C. § 1052(d).

3 **2. The Applications for the Marks OPTIFLOW and OPTI-LIGHT Raise**
4 **Virtually Identical Issues and Arguments Regarding Confusion with**
5 **Opposer's Marks OPTI, OPTI-GUARD, OPTI-MAX, OPTI-SEAL, and**
6 **OPTIMIZE TECHNOLOGIES.**

7 Opposer further argues that pursuant to the allegations stated above, in both
8 proceedings that registration of the Applicant's marks at issue will also falsely suggest a
9 connection with Opposer and result in damage to Opposer under the provisions of Section
10 2(a) of the U.S. Trademark Act, 15 U.S.C. § 1052(a).

11 **3. The Applications for the Marks OPTIFLOW and OPTI-LIGHT Raise**
12 **Virtually Identical Issues and Arguments Regarding Damage to Opposer's**
13 **Marks OPTI, OPTI-GUARD, OPTI-MAX, OPTI-SEAL, and OPTIMIZE**
14 **TECHNOLOGIES.**

15 Finally, Opposer argues in both proceedings that Opposer will be damaged if
16 Applicant obtains a registration for the OPTIFLOW and OPTI-LIGHT marks because
17 Applicant will obtain statutory rights in the marks in violation and in derogation of the
18 established prior rights of Opposer in its OPTI and OPTI prefixed marks.

19 **III. CONCLUSION**

20 Given the highly similar nature of both Opposition Proceeding Number 91158331 and
21 Opposition Proceeding Number 91156666, it is clear that these two proceedings may be
22 presented on the same record and briefs without appreciable inconvenience or confusion, and
23 that consolidation would be advantageous in the avoidance of the duplication of effort, loss of
24 time, and the extra expense involved in conducting the proceedings.

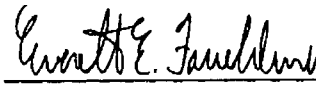
25 Opposer requests that the present Opposition Proceeding Number 91158331 be
26 designated as the "parent" case in which all papers shall be filed, adopting the trial and
27 deadline schedule of Opposition Proceeding Number 91158331, notwithstanding every paper
henceforth referencing both proceeding numbers. As set forth in the Proposed Order included
herewith, if the Board is unable to reach a decision on the instant motion by April 1, 2004,

1 Opposer proposes an alternative schedule for the consolidated proceedings, established from
2 the date the Board rules on this motion.

3 Dated this 16th day of March 2004.

Respectfully submitted,

CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}



James W. Anable, Registration No. 26,827
Everett E. Fruehling
Attorneys for Opposer Optimize
Technologies, Inc.

CERTIFICATE OF SERVICE

14 I hereby certify that on the 16th day of March, 2004, a true copy of the foregoing
15 Memorandum in Support of Motion to Consolidate Opposition Proceedings, in Opposition No. 91158331, was
16 served on attorneys for Applicant by depositing a true and correct copy thereof in the United States mail in a
sealed envelope with postage thereon fully prepaid, addressed as follows:

17 Stanley C. Macel, III, Esq.
18 Connolly Bove Lodge & Hutz LLP
1007 North Orange Street
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19 Executed on March 16, 2004



21 EEF:sjp/skk